

REMARKS

This Amendment is in response to the Office Action mailed August 20, 2004. Claims 1-12 are pending in the application. Claims 1, 2, 9 and 12 are rejected and claims 3-8, 10 and 11 are objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claim. Applicants respond to the rejection of claims 1, 2, 9 and 12 and other informalities as follows.

**Response to Objection to the Abstract**

The Abstract was objected to because it does not describe the invention now being claimed. Applicants have amended the abstract to recite a method of balancing a spindle or rotating assembly as set forth in the claims. Based upon the foregoing, reconsideration and withdrawal of the objection to the Abstract is respectfully requested.

**Response to rejection of claims 1, 2, 9 and 12**

**under 35 U.S.C. § 102(b)**

Claims 1, 2, 9 and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by Craig, U.S. patent No. 4,003,265 on that basis that Craig discloses that a spindle assembly is balanced using a plurality of adjustable eccentric rings and the disclosure of Craig at col. 5, lines 53-61. To establish a *prima facie* basis to reject claims 1, 2, 9 and 12 under 35 U.S.C. § 102(b), the prior art reference must expressly or inherently teach each of the recited claim limitations. Craig does not teach or suggest each of the recited claim elements as follows.

Claims 1, 2 and 9 as amended recite *inter alia* the steps of measuring an imbalance of a combination of a spindle assembly and eccentric rings preassembled with the spindle assembly and adjusting the eccentric rings based upon the measured imbalance of the combination of the spindle assembly and the eccentric rings. Claim 12 recites *inter alia* the step of

adjusting eccentric rings to dynamically balance a spindle assembly based upon a measured imbalance of a combination of the spindle assembly and the eccentric rings.

Col. 5, lines 53-61 of Craig as cited in the Office Action discloses use of "equipment known as dynamic balancer which automatically determines the mass imbalance of a rotating system". Mere measurement of balance of a rotating system is legally insufficient to reject claims 1, 2 and 9 which recite a method step of measuring an imbalance of a **combination** of a spindle or rotating system and preassembled eccentric rings and claim 12 which recites the step of adjusting eccentric rings based upon a measured imbalance of the **combination** of a spindle or rotating assembly and eccentric rings.

The prior art reference must teach the steps of measuring an imbalance of the **combination** of the rotating or spindle assembly and the eccentric ring as recited in claims 1, 2, and 9 or adjusting eccentric rings based upon a measured imbalance of the **combination** of the rotating or spindle assembly and eccentric rings as recited in claim 12. Rejection of claims 1, 2, 9 and 12 based upon a method of measuring imbalance of a rotating system and not the recited combination of the spindle assembly and preassembled eccentric rings or steps of claims 1, 2, 9 and 12 is not proper and is erroneous.

Col. 5, line 60-Col. 6, line 6 of Craig discloses a system that uses a dynamic balancer to determine mass imbalance that can be used for aligning balancing weights **when inserting the balancing weights** into the rotating assembly. This teaches measuring imbalance of the rotating assembly and then inserting the balancing weights as distinguished from measuring an imbalance of the combination as recited in claims 1, 2, 9 or adjusting balance based upon a measured imbalance of the combination as recited in claim 12.

As described in an embodiment of Applicants' specification, "the imbalance of the spindle assembly is measured with the rings preassembled in the spindle assembly in the dynamically balanced position. This provides advantages and flexibility over prior system where the spindle is balanced prior to completion of the spindle assembly". Applicants' specification page 8, lines 15-20. As described in embodiments of Applicants' specification, the imbalance can be measured and the rings adjusted as the spindle assembly -with the preassembled eccentric rings- is conveyed along a conveyor assembly for ease of manufacture and efficiency.

Based upon the foregoing, reconsideration and allowance of claims 1, 2, 9 and 12 are respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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